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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,544	10/01/2003	Masatoshi Ito	11835/12	5749

7590 12/03/2004

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EXAMINER


BOTTORFF, CHRISTOPHER

ART UNIT	PAPER NUMBER
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3618

DATE MAILED: 12/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/674,544	Applicant(s) ITO ET AL. 	
	Examiner Christopher Bottorff	Art Unit 3618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2004.
 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
 4a) Of the above claim(s) 2-5 is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☒ The drawing(s) filed on 01 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/684,422.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The preliminary amendment filed October 1, 2003 has been entered.

Election/Restrictions

Applicant's election of Species II, corresponding to Figures 9-11 and claim 1, in the reply filed on October 6, 2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 2-5 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected species, there being no allowable generic or linking claim. Claim 1 is currently under consideration. Claims 1-5 remain pending.

Priority

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/684,422, filed on October 6, 2000.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on October 1, 2003 was considered by the examiner.

Claim Objections

Claim 1 is objected to because of the following informalities: sections (e) and (f) recite second and third rotary members, however, these features are defined in section (d) as "elements" rather than "members." This inconsistent language suggests that the elements and members are distinct features. Appropriate correction is required. In the event that the elements and members are distinct features, the second and third rotary members are indefinite in that they lack proper antecedent basis.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 recites a forward-motor-drive control means, a forward-engine-drive control means, and a mode selecting means. However, the disclosure does not describe the structure that each of the means comprises. Page 31, lines 1-4, of the specification describes a control device 60 having a CPU, RAM, and ROM. Page 33 of the specification indicates that control device 60 includes distinct structures in the form of a forward-motor-drive control means 104, forward-engine-drive control means 112, and mode determining means 114. These means are depicted in Figure 6. However,

the specification fails to describe the actual distinct structures of the various means in a way that would allow one of ordinary skill in the art to make the claimed invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Since the structure that comprises of each claimed means is not described in the disclosure, the subject matter that comprises each claimed means is unclear. For the purposes of examination, each claimed means is interpreted as being a portion of a generic microprocessor and the means-plus-function limitations of sections (g), (h), and (i) are interpreted as functional limitations relating to a generic structure without invoking 35 USC 112, sixth paragraph.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuzuki et al. US 6,018,198.

Tsuzuki et al. discloses a hybrid drive system for an automotive vehicle having an engine 1, an electric motor 2, an output member 7 connected to a drive wheel 8, a planetary gear device 40A, first 42 and second 41 clutches, and control means 5. See Figure 16; column 19, lines 34-52; and column 10, lines 9-45.

The planetary gear device includes a first rotary element 45 connected to the engine, a second rotary element 43 connected to the electric motor, and a third rotary element 44. The second rotary element is connected to the output member through the first clutch. The third rotary element is connected to the output member through the second clutch. The control means provides for motor drive control, engine drive control, clutch control, and mode selection. See column 10, lines 19-21, and column 11, lines 1-18. Also, the control means is capable of being programmed to control the engine, motor, and clutches to perform the claimed function.

While the functional limitations of the apparatus claims have been fully consider, they fail to distinguish the claimed invention over the prior art. It is well settled that claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847 (CCPA 1959).

"[A]pparatus claims cover what a device *is*, not what a device *does*." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469 (Fed. Cir. 1990). (emphasis in original). A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

Here, Tsuzuki et al. teaches all of the structural limitations of the claims, and this apparatus is capable of functioning as claimed. Although the operating process of the apparatus of Tsuzuki et al. may differ from the operating process of the claimed apparatus, the claimed apparatus does not distinguish over the apparatus of Tsuzuki et al. In fact, modifying the operating process of the apparatus of Tsuzuki et al. would have been obvious to one of ordinary skill in the art at the time the invention was made. This modification would the performance of the apparatus to be optimized for a particular operating condition.

Conclusion

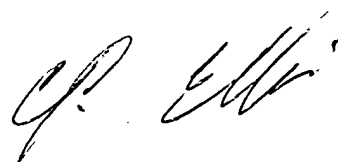
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Buschhaus et al., Hara et al., Kubo, Tamagawa et al., Aoyama et al., Kitada et al., Oyama, Severinsky, Lutz, Takashima et al. disclose hybrid drive systems.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Bottorff whose telephone number is (703) 308-2183. The examiner can normally be reached on Mon.-Fri. 7:30 a.m. - 4:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Ellis can be reached on (703) 308-2560. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Christopher Bottorff



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